

Applicants : Iris BAHIR & Shmuel BEN-SASSON
U.S. Serial No. : 10/550,870
Filed : July 24, 2006
Page : 2

Election/Restrictions Requirement

The Examiner to whom this application is assigned indicated that under 35 U.S.C. § 121 and 372, restriction to one of the following groups of inventions is required:

Group I, claim(s) 25, 30-33, 39-44, drawn to a method for generating genetically diverse plants via the incorporation of exogenous microsatellite sequence into the plant genome of the same species.

Group II, claim(s) 26 and 28, drawn to method of Group I, wherein MS-like DNA fragment comprises a monotonous repeat of one to six nucleotides and is at least twelve nucleotides in length.

Group III, claim(s) 27 and 29, drawn to the method of Group I, wherein MS-like DNA fragment comprises a sequence that is at least 70% homologous to a monotonous repeat of one to six nucleotides and is at least twelve nucleotides in length.

Group IV, claim(s) 34, drawn to the method of Group I, wherein MS-like DNA fragment further comprises in tandem a unique identifiable sequence that enables specific tagging of the incorporated DNA.

Group V, claim(s) 35-36, drawn to the method of Group I, wherein the MS-like DNA is introduced into individual cells.

Group VII, claim(s) 37-38, drawn to the method of Group I, wherein the MS-like DNA is introduced into any one of a plant embryo, tissue or callus or a leaf.

Applicants : Iris BAHIR & Shmuel BEN-SASSON
U.S. Serial No. : 10/550,870
Filed : July 24, 2006
Page : 3

Group VIII, claim(s) 45-48, drawn to a method for generating genetically diverse plants via the incorporation of exogenous microsatellite sequence into the plant genome.

In response, Applicants respectfully traverse the above restriction.

Under 37 C.F.R. 1.475(b), an international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

Applicants submit that claims 25-44, Groups I to Group VII, do not require restriction as they are connected by a single relationship, namely a method for generating genetically diverse plants via the incorporation of exogenous microsatellite sequence into the plant genome.

Applicants : Iris BAHIR & Shmuel BEN-SASSON
U.S. Serial No. : 10/550,870
Filed : July 24, 2006
Page : 4

The Examiner contends that the claimed method is anticipated by LeClere et al. (Plant Molecular Biology 46:695-703 (2001)). The Examiner contends that LeClere et al. teach that cDNAs of Arabidopsis with oligo(dT) were generated and binary vectors containing the cDNA library were transformed into Arabidopsis. Given that the cDNA with oligo dT meets the definition of MS-like DNA fragment, the reference anticipates the method of claim 1. Applicants respectfully traverse.

Applicants submit that claim 25 is drawn to a method of generating genetically diverse plants via the incorporation of exogenous microsatellite sequence into the plant genome. Microsatellite sequence is a well-known term in the art, and one of ordinary skill in the art would readily understand and recognize what is a microsatellite sequence (see page 1, 3rd paragraph). One of ordinary skill in the art would not define or accept cDNA with oligo dT as microsatellite sequence. LeClere et al. only teach cDNA library; LeClere et al. do not teach or suggest a method of using microsatellite sequence. Hence, LeClere et al. do not anticipate the method of claim 25, and claims 25-44 are all related to a single general inventive concept. Accordingly, Applicants respectfully request the restriction of claims 25-44 be withdrawn.

Election of Invention

In the event the above discussion does not convince the Examiner to withdraw the restriction requirement, Applicants hereby elect with traverse Group I, claims 25, 30-33, 39-44 for examination.

Applicant(s) : Iris BAHIR and Shmuel BEN-SASSON
Application No. : 10/550,870
Filing Date : July 24, 2006
Page : 5

Conclusion

On the basis of the foregoing remarks, Applicants respectfully request reconsideration and withdrawal of the restriction requirement. If a telephone interview would be of assistance in advancing the prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided below. If any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 50-1891.

Respectfully submitted,

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